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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,966	03/25/2004	Will Shatford	46834-1200	7063
21611	7590	03/30/2007	EXAMINER	
SNELL & WILMER LLP (OC) 600 ANTON BOULEVARD SUITE 1400 COSTA MESA, CA 92626			POLLICOFF, STEVEN B	
			ART UNIT	PAPER NUMBER
			3728	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	03/30/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/808,966	SHATFORD ET AL.
	Examiner	Art Unit
	Steven B. Pollicoff	3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 January 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 2,6-9 and 15 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3-5 and 10-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1, line 2 provides for a seamless tube "adapted to contain **only** one light bulb". However, the specification does not contemplate such an amendment to the claim. The specification provides for a seamless tube "sufficiently flexible to allow insertion of one or more light bulbs" (specification page 4, line 1). Thus, as provided by the original specification, it seems Applicant intended a seamless tube having **at least** one bulb, but certainly not limited to just one. Correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Lawrence et al., (U.S. Pat. No. 5,553,708).

As to claims 1 and 3, Lawrence discloses a container for light bulbs comprising a seamless tube of puncture resistant plastic (Lawrence Fig 1 and 7 ref 26; see also column 4, lines 46-50) **capable of being adapted to contain only one light bulb** having an open end and sealed at the other end (Fig 1 generally) and means for sealing the open end for a glass shard puncture resistant gas impervious container (Fig 8 the cable strap ref 28). Lawrence also discloses, in as much as applicant defines an insert, an insert (Fig 8 ref 54) capable of absorbing gases.

As to claim 10, Lawrence discloses a heavy paper liner (Column 4, line 67 and continued on Column 5, lines 1-9) disposed in a light mil plastic bag (Column 4, lines 47-55).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence et al., (U.S. Pat. No. 5,553,708).

As to claim 11, it would have been obvious to one having ordinary skill in the art at the time the invention was made to change the thickness of plastic tube of Lawrence from 4 mil to 2 mil since it has been held within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (i.e. sufficient thickness for shards of glass) as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claims 4,5 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence et al., (U.S. Pat. No. 5,553,708) in view of Cullen (U.S. Pat. No. 5,069,694).

As to claims 4,5 and 12-14, Lawrence does not disclose that the tube comprises a desiccant package of sulfur impregnated activated carbon granules or a strip of sulfur impregnated activated carbon paper. However, Cullen discloses a desiccant package of sulfur impregnated activated carbon granules or alternatively an envelope with sheets of carbon loaded paper that can be placed in an environment to protect the contents from harmful gases (Cullen Column 1, lines 36-42; Column 2, lines 47-53; Column 3, lines 23-33). The teaching also suggests a combination of the various embodiments such that it would be reasonable to have the carbon paper impregnated with sulfur or other absorbents as disclosed in Cullen. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the tube of Lawrence to include a desiccant package or a strip of carbon paper lined/impregnated with sulfur or

sulfur chalk, as taught by Cullen, to prevent the harmful effects of gases on the contents enclosed in the environment.

### ***Response to Arguments***

Applicant's arguments filed 1/9/07 have been fully considered but they are not persuasive. Applicant argues that Lawrence does not teach amended claim 1. This is unpersuasive as Lawrence clearly teaches a disposal bag for fluorescent bulbs having a seamless tube of puncture resistant plastic ***capable of being adapted to contain only one light bulb*** having an open end and sealed at the other end; and means for sealing the open end after a spent bulb is inserted inside the tube for providing a glass shard puncture resistant gas impervious container. With respect to claim 3, Applicant argues Lawrence does not contemplate an insert for absorbing gases from a broken light bulb. This is unpersuasive because in as much as Applicant defines the structure of the insert, the foam of Lawrence clearly reads on it. Additionally, it is well settled that it is possible for functional language to define structure, but that where no distinguishing structure has been defined, the claim is not patentable and is fully met by the reference. In re Swinehart, 169 USPQ 226. See also General Electric v. United States, 198 USPQ 73 which further reinforced the concept that functional language which defines no structure cannot distinguish over the prior art. Here, Lawrence discloses a foam insert (i.e. a porous, absorbent material) certainly capable of absorbing gases released by a broken bulb. Applicant further argues, with respect to claims 10 and 11, that Lawrence does not disclose that the tube comprises a puncture resistant light mil plastic with a heavy paper lining. This is unpersuasive because in as much as Applicant defines the

structural relationship between the plastic tube and the paper liner, Lawrence clearly teaches the limitation that the tube comprises a puncture resistant light mil plastic (Lawrence Fig 1 ref 26) with a heavy paper liner (ref 22). Applicant argues, with respect to claims 4,5 and 12-14, that Cullen, teaches the exact opposite of the present invention in terms of the function of the desiccant and carbon paper. This is unpersuasive because Lawrence as modified by Cullen clearly teaches that by providing the desiccant and/or the carbon paper, undesirable gases are absorbed from the packaged environment. It is immaterial that Cullen may teach absorbing harmful gases to protect items such as silverware as opposed to Applicant's purpose of preventing harmful gases from escaping the tube environment. Either way, Cullen teaches providing the desiccant/carbon paper to absorb harmful gases.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. Pollicoff whose telephone number is (571)272-7818. The examiner can normally be reached on M-F: 7:30A.M.-4:00P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

4bp 3/26/07  
SBP



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